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PATENT & TRADEMARK

Docket No.: INS0009US

July 15, 2005

MAIL STOP APPEAL BRIEF- PATENTS
COMMISSIONER FOR PATENTS
P. O. BOX 1450
ALEXANDRIA, VA 22313-1450

Re:	Applicant(s):	Curtis Ohrt		
	Assignee:	InsWeb Corporation		
	Title:	Insurance Rating Calculation Software Component Architecture		
	Serial No.:	09/504,978		
	Examiner:	N. Pass	Filed:	February 15, 2000
	Docket No.:	INS0009US	Group Art Unit:	3626

Dear Sir:

Transmitted herewith are the following documents in the above-identified application:
    (1) Return Receipt Postcard;
    (2) This Transmittal Letter (1 page) (in duplicate); and
    (3) Supplemental Appeal Brief (23 pages).

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_____   7/15/05
Attorney for Applicant(s)   Date of Signature

Respectfully submitted,

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      Assignee: InsWeb Corporation
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Attorney for Applicant(s)   Date of Signature

Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant(s):	Curtis Ohrt
Assignee:	InsWeb Corporation
Title:	Insurance Rating Calculation Software Component Architecture

Serial No.:	09/504,978	Filing Date:	February 15, 2000
Examiner:	N. Pass	Group Art Unit:	3626
Docket No.:	INS0009US		

Austin, Texas
July 15, 2005

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SUPPLEMENTAL APPEAL BRIEF

Dear Sir:

This Supplemental Appeal Brief is submitted in response to the remand of July 5, 2005, of the above-referenced case by the Board of Patent Appeals and Interferences. This Supplemental Appeal Brief addresses the Board's requirement regarding the Summary of Invention (labeled "Summary of Claimed Subject Matter" below). Additionally, since this Supplemental Appeal Brief is filed subsequent to rules changes effective September 13, 2004, the format of the brief has changed to conform to the new rules. In all other respects, this Supplemental Appeal Brief is substantially the same as the appellant's Appeal Brief of November 25, 2003.

No fee is believed to be necessary for this Supplemental Appeal Brief. However, please charge deposit account No. 502306 for any sums which may be required to be paid as part of this appeal.

REAL PARTY IN INTEREST

The real party in interest on this appeal is InsWeb Corporation.

RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences related to this application.

STATUS OF CLAIMS

Claims 1-23 stand rejected under 35 U.S.C. § 112, second paragraph.

Claims 1-3, 5, 6, and 12-23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tyler et al., U.S. Patent No. 5,523,942 (Tyler) in view of McClelland et al., U.S. Patent No. 5,689,650 (McClelland).

Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over Tyler in view of McClelland, and further in view of Adunuthula et al., U.S. Patent No. 6,026,404 (Adunuthula).

Claims 7, 9, and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tyler in view of McClelland, and further in view of Batz et al., U.S. Patent No. 5,918,022 (Batz).

Claim 8 stands rejected under 35 U.S.C. § 103 as being unpatentable over Tyler in view of McClelland and Batz, and further in view of Narayanan et al., U.S. Patent No. 5,689,664 (Narayanan).

Claim 10 stands rejected under 35 U.S.C. § 103 as being unpatentable over Tyler in view of McClelland and Batz, and further in view of Adunuthula.

Claims 1-23 are being appealed.

STATUS OF AMENDMENTS

No amendments were filed subsequent to the final rejection of April 22, 2003.

SUMMARY OF CLAIMED SUBJECT MATTER

The invention is as set forth in the claims. To summarize the invention without intending to limit or otherwise affect the scope of the claims, the invention, as set forth by independent claim 1, relates to a product rate calculation system (e.g., **Figure 2**) including a product application (e.g., **200**; page 9, line 20 through page 10, line 13; **Figure 3**; and page 11, line 25 through page 13, line 16), a first support software component (e.g., **134, 154**), and a first protocol stack (e.g., **136, 156**). The product application is operable to provide product information to, and receive consumer information from a user (e.g., **260**, see also **Figure 3** and page 11, line 25 through page 13, line 16). Additionally, the product application is operable to send a call to a product rate calculation software component (e.g., page 10, lines 14-29, **142, 163, 210-230**). The first support software component can receive the call from the product application, and the first protocol stack can process the call into a protocol for transmission over a communication link (e.g., **Figures 1B** and **1C**, and page 7, line 16 through page 8, line 12).

Another aspect of the invention, as set forth in independent claim 16, relates to a method of calculating a product rate. A request for a product rate is received from a user (e.g., **340** and page 12, lines 16-20). The request for a product rate is converted into a call to a product rate calculation software component (e.g., **345**, page 12, lines 21-26, **Figure 2**, and page 10, lines 14-29). The call to a product rate calculation software component (e.g., **142, 163, 210-230**) is sent to a first support software component (e.g., **134, 154**). The first support software component receives the call to a product rate calculation software component. The call to a product rate calculation software component is processed into a protocol for transmission over a communication link. The call to a product rate calculation software component is transmitted over the communication link. See, e.g., **Figures 1B** and **1C**, and page 7, line 16 through page 8, line 12.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

I.   Claims 1-15 are rejected under 35 U.S.C. § 112, second paragraph.

II. Claims 16-23 are rejected under 35 U.S.C. § 112, second paragraph.

III. Claims 1-15 are rejected under 35 U.S.C. § 103(a) over Tyler, McClelland, Batz, Adunuthula, and Narayanan taken alone or in combination.

IV. Claims 16-23 are rejected under 35 U.S.C. § 103(a) over Tyler and McClelland taken alone or in combination.

Note that to the extent necessary, the grouping of the claims is as follows: Issue I: Claims 1-15 stand or fall together; Issue II: Claims 16-23 stand or fall together; Issue III: Claims 1-15 stand or fall together; Issue IV: Claims 16-23 stand or fall together.

ARGUMENT

Issue I: Whether claims 1-15 are properly rejected under 35 U.S.C. § 112, ¶2

Claims 1-15 stand rejected under 35 U.S.C. § 112, second paragraph. More specifically, claim 1 is rejected "as being incomplete for omitting essential elements, such omission amounting to a gap between the elements." Office Action of September 12, 2002, p. 3, ¶2.

In her Office Action of September 12, 2002, p. 3, ¶¶2-3, the Examiner states:

The omitted elements are:

Claim 1 recites a "product rate calculation system" in its preamble, but only recites three elements in its body . . . . It is unclear as to which element performs the "rate calculation" function recited in the preamble. Simple stated, does the claimed product application or the claimed first support software component or the claimed first protocol stack perform the act of "product rate calculation", or is there another element responsible for this function? As such, the claim, as presently recited, appears to be incomplete.

The appellant respectfully disagrees. In making her rejection, the Examiner appears to rely on form paragraph 7.34.13 as described in MPEP § 706.03(d). The instructions for use of form paragraph 7.34.13 make clear that the Examiner is to (1) recite the elements omitted by the claim, and (2) provide the rationale for considering the omitted elements critical or essential. The Examiner has done neither. The Examiner has recited no elements purportedly omitted from the claim. At best, the Examiner has made

reference to the preamble. The appellant notes that MPEP §2111.02 discusses generally the weight of claim preambles. In particular it states that:

> The preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be "essential to point out the invention defined by the claim." (Citation omitted).

Thus, if it is the Examiner's position that the preamble is "essential to point out the invention defined by the claim," the appellant respectfully requests clarification of this point. Whether or not that is the Examiner's position, the appellant also respectfully requests that the Examiner provide the *rationale* for considering the omitted elements critical or essential.

In her Final Office Action of April 22, 2003, p. 5, ¶2, the Examiner fails to respond to these arguments and requests, and simply states:

> The cited claims fail to interrelate essential elements of the invention and therefore fail to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Further, Applicant's remarks apparently suggest that the "calculation of a product rate" is not what the Applicant seeks patent protection for.

Thus, the Examiner has provided no specific indication of the elements omitted by the claim, and more importantly the Examiner has provided no rationale for considering the omitted elements critical or essential. Additionally, the appellant respectfully submits that whether or not the Examiner's characterization of the appellant's remarks is correct (and the appellant does not concede this point) the Examiner's characterization of the appellant's remarks does nothing to identify the purported missing elements and the rationale for considering those elements essential.

Accordingly, the appellant respectfully submits that claim 1 is definite and allowable. Claims 2-15 depend from claim 1 and are allowable for at least this reason.

Issue II: Whether claims 16-23 are properly rejected under 35 U.S.C. § 112, ¶2

Claims 16-23 stand rejected under 35 U.S.C. § 112, second paragraph. More specifically, claim 16 is rejected "as being incomplete for omitting essential steps, such omission amounting to a gap between the steps." Office Action of September 12, 2002, p. 3, ¶5.

In her Office Action of September 12, 2002, p. 3, ¶¶5-6, the Examiner states:

The omitted steps are:

Claim 16 recites a "method calculating a product rate" in its preamble, but recites six steps in its body . . . . It is unclear as to which step performs the "calculating product rate" function recited in the preamble. . . . As such, the claim, as presently recited, appears to be incomplete.

The appellant respectfully disagrees for reasons similar to those stated above with respect to claim 1. In making her rejection, the Examiner appears to rely on form paragraph 7.34.12 as described in MPEP § 706.03(d). The instructions for use of form paragraph 7.34.12 make clear that the Examiner is to (1) recite the steps omitted by the claim, and (2) provide the rationale for considering the omitted steps critical or essential. The Examiner has done neither. The Examiner has recited no steps omitted from the claim. At best, the Examiner has merely made reference to the preamble. The appellant notes that MPEP §2111.02 discusses generally the weight of claim preambles. In particular it states that:

The preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be "essential to point out the invention defined by the claim." (Citation omitted).

Thus, if it is the Examiner's position that the preamble is "essential to point out the invention defined by the claim," the appellant respectfully requests clarification of this point. Whether or not that is the Examiner's position, the appellant also respectfully requests that the Examiner provide the _rationale_ for considering the omitted steps critical or essential.

The above quoted portion of the Examiner's Final Office Action of April 22, 2003, p. 5. ¶2, appears intended to also apply to the appellant's requests and arguments regarding the rejection of claim 16. As such, the appellant respectfully reiterates his position as stated above that the Examiner's response fails to identify the purported missing steps and fails to identify the rationale for considering those steps essential.

Accordingly, the appellant respectfully submits that claim 16 is definite and allowable. Claims 17-23 depend from claim 16 and are allowable for at least this reason.

Issue III: Whether claims 1-15 are patentable under 35 U.S.C. § 103(a) over Tyler,
McClelland, Batz, Adunuthula, and Narayanan taken alone or in combination

Claims 1-3, 5, 6, and 12-15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tyler et al., U.S. Patent No. 5,523,942 (Tyler) in view of McClelland et al., U.S. Patent No. 5,689,650 (McClelland). Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over Tyler in view of McClelland, and further in view of Adunuthula et al., U.S. Patent No. 6,026,404 (Adunuthula). Claims 7, 9, and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tyler in view of McClelland, and further in view of Batz et al., U.S. Patent No. 5,918,022 (Batz). Claim 8 stands rejected under 35 U.S.C. § 103 as being unpatentable over Tyler in view of McClelland and Batz, and further in view of Narayanan et al., U.S. Patent No. 5,689,664 (Narayanan). Claim 10 stands rejected under 35 U.S.C. § 103 as being unpatentable over Tyler in view of McClelland and Batz, and further in view of Adunuthula. The appellant respectfully traverses these rejections.

None of the cited references teach or suggest a product rate calculation system including:

> a product application operable to provide product information to and
> receive consumer information from a user, and further operable to send a
> call to a product rate calculation software component;

> a first support software component operable to receive the call from the
> product application; and

> a first protocol stack operable to process the call into a protocol for
> transmission over a communication link,

as required by independent claim 1.

Regarding claim 1, the Examiner states in her Office Action of September 12, 2002, p. 4, no. 7(A), that the claimed product application operable to provide product information to and receive consumer information from a user is taught by Tyler at column 5, lines 32-41. The cited portion of Tyler states:

> Typical functions that can be performed by the present invention include:
> (i) collecting information required to design an insurance product for a

customer; (ii) receiving a request for information about an insurance
product or policy; (iii) accessing stored information, such as rates,
performing the necessary calculations based on the request and returning
the requested information to the user; and (iii) displaying policy level and
component level information at both a "point in time" and over one or
more time intervals.

The appellant respectfully submits that the particular parts of the cited reference that the
Examiner has relied upon have not been designated as nearly as practicable, and the
pertinence of the reference has not been clearly explained, both as required by 37 C.F.R.
§ 1.104(c)(2). *See also* MPEP § 706.02(j). In particular, the Examiner has not stated
what in the cited portion of Tyler she contends teaches the claimed product application
operable to provide product information to and receive consumer information from a
user. For example, if it is the Examiner's position that the limitation is taught by "the
present invention" of Tyler, then the appellant respectfully submits that the Examiner's
obligations under 37 C.F.R. § 1.104(c)(2) have not been met. Moreover, the appellant
notes that the cited portion of Tyler merely refers to functions of the "present invention"
and does not teach or suggest the claimed product application operable to provide product
information to and receive consumer information from a user.

In her Final Office Action of April 22, 2003, pp. 5-6, no. (B), the Examiner fails
to respond to these arguments and requests, and instead merely reiterates the previous
rejection:

> ... all of the limitations which Applicant disputes are missing in the
> applied references, including the features discussed by Applicant in the 13
> January 2003 amendment, have been fully addressed by the Examiner ...
> as detailed in the 35 USC § 103 rejections given in the preceding sections
> of the present Office Action and in the prior Office Action (paper number
> 5), and incorporated herein. In particular, Examiner notes that the
> limitations ... are taught by the cited references.

Thus, the Examiner has provided no meaningful response to the appellant's argument that
the Examiner's obligations under 37 C.F.R. § 1.104(c)(2) have not been met, or to the
appellant's assumption regarding the Examiner's argument and the corresponding
response to the Examiner's argument.

As for the claim limitation that the product application is further operable to send

a call to a product rate calculation software component, it appears that the Examiner believes the product rate calculation software component to be taught by Tyler's Calculation Engine **16**. However, the appellant respectfully submits that none of the things to which the Examiner refers as teaching the claimed product application are operable to call Calculation Engine **16**.

Again, In her Final Office Action of April 22, 2003, pp. 5-6, no. (B), the Examiner fails to respond to this argument and merely reiterates the previous rejection.

Regarding the claimed a first support software component operable to receive the call from the product application, the Examiner refers to column 5, lines 18-32 of Tyler. Office Action of September 12, 2002, p. 5, no. ¶1. The cited portion of Tyler states:

> At its highest level of functionality, the present invention operates as follows. Information about insurance product rules and rates is stored in the memory of a digital computer. The information may be stored as data or as procedures that carry out specific functions. The digital computer is supplied with a specific information request. The information request may be for information about a proposal, or may be a request for sales support, or a request that the system of the present invention perform a product administrative function. In conjunction with the user, the digital computer determines the information request requirements, accesses the required rates, calculates the required information, and displays it to the user or passes it to another computer system.

The appellant again respectfully submits that the particular parts of the cited reference that the Examiner has relied upon have not been designated as nearly as practicable, and the pertinence of the reference has not been clearly explained, both as required by 37 C.F.R. § 1.104(c)(2). In particular, the Examiner has not stated what in the cited portion of Tyler she contends teaches the claimed a first support software component operable to receive the call (i.e., the call to a product rate calculation software component) from the product application. The appellant respectfully submits that nothing in the cited portion of Tyler teaches this limitation.

As before, the Examiner's Final Office Action of April 22, 2003, pp. 5-6, no. (B), fails to respond to this argument and merely reiterates the previous rejection.

The appellant notes that in the Final Office Action of April 22, 2003, pp. 6-7, no.

(C), the Examiner states:

> . . . Applicant analyzes the applied references separately and argues each of the references individually.

> In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, . . . ; In re Merck & Co. . . . .

With respect to the arguments presented in the prosecution of the present application, the appellant respectfully submits that the Examiner has misapplied the holdings of *In re Keller* and *In re Merck & Co.*

Neither case stands for the proposition that an appellant cannot argue, as the appellant has argued in prosecuting the present application, that a reference purported to teach one or more claim elements does not in fact teach those claim elements. MPEP § 2143 makes clear that one of the requirements for establishing a *prima facie* case of obviousness is that the prior art reference or references must teach or suggest all of the claim limitations. To the extent that the appellant has "[attacked] references individually" it has only been to rebut the Examiner's arguments regarding claim limitations purportedly taught by each reference individually. Such an approach is completely acceptable.

The Examiner's statement is only true with regard to another element of a *prima facie* case of obviousness, namely the requirement that there is some suggestion or motivation to combine the references either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. That this is true can be seen from a more careful examination of the cited cases.

In *In re Keller*, all claim elements were found to be taught in the prior art and so the issue before the court was the suggestion or motivation to combine the references:

> Both Keller and Berkovits disclose heart stimulators that use R-C timing circuits. Walsh teaches the use of digital type timing circuits in place or R-C type timing circuits in conventional heart stimulators. Therefore, the question is whether it would have been obvious to one of ordinary skill in the art, working with the Keller and the Berkovits and the Walsh references before him, to do what the inventors herein have done, that is,

to use a digital timing circuit in a cardiac pacer. *In re Keller*, 208 USPQ 871, 881-2 (CCPA 1981).

With a *prima facie* case of obviousness established, the burden to prove non-obviousness shifted to the appellant. *Id* at 882. The appellant attempted to rebut the *prima facie* case of obviousness with objective evidence of non-obviousness, namely the Cywinski affidavit:

> As characterized by appellant, the Cywinski affidavit offered as objective evidence of non-obviousness "concerns itself mainly with the question of whether the Walsh et al. article suggest [sic] the use of digital timing in a cardiac pacer." But one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references. *Id.*

Thus, *In re Keller* stands for the proposition that when rebutting an argument regarding the suggestion or motivation to combine references, one cannot attack the references individually.

> In *In re Merck & Co.*, the issue was also the combination of references:

> We also find untenable appellant's arguments that Petersen teaches away from appellant's invention. Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references. [citing *In re Keller*] Thus, Petersen must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole. That teaching is that the interchange of the nitrogen and the unsaturated carbon atoms is isomeric and compounds so modified are expected to possess similar biological properties. *In re Merck & Co.*, 231 USPQ 375, 380 (Fed. Cir. 1986).

Thus, *In re Merck & Co.* also stands for the proposition that when rebutting an argument regarding the suggestion or motivation to combine references, one cannot attack the references individually.

In contrast, the appellant's arguments with respect to the motivation or suggestion to combine Tyler and McClelland do not attack the references individually. Accordingly, the appellant respectfully submits that the Examiner's statement is inapplicable to the present case.

As for the combination for Tyler and McClelland, the Examiner states:

- 12 -

It would have been obvious to one of ordinary skill in the art . . . to modify the product rate calculation system of Tyler to include a first protocol stack operable to process the call into a protocol for transmission over a communication link, as taught by McClelland, with the motivation of providing a user interface for the network serving as a link between a requesting user and the fulfillment source (McClelland; column 4, lines 46-49. Office Action of September 12, 2002, p. 5, ¶4.

The appellant respectfully disagrees. The cited portion of McClelland states, "Another computerized process provides the user interface for the network and may also serve as a link between investor CRA requirements and the investment advisor's fulfillment of those requests." The cited portion of McClelland merely reiterates what the Examiner has already cited as teaching or suggesting the claimed a first protocol stack, i.e., column 20, line 65 to column 21, line 19. Thus, the Examiner's purported motivation to combine is not a motivation to combine the inter-process communication of McClelland of with any of the teachings of Tyler, but merely a brief description of one part of that inter-process communication, i.e., the "[a]nother computerized process."

Instead of responding to this specific argument regarding the Examiner's analysis in support of the combination of McClelland and Tyler, the Examiner: (1) simply reiterates the same purported motivation (Final Office Action of April 22, 2003, p. 10, no. (D) to which the appellant has already responded); and (2) makes abundant reference to the well established principle that the suggestion or motivation to combine references must be found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art (See, generally, Final Office Action of April 22, 2003, pp. 7-10).

To that end, the Examiner states: "The Examiner is concerned that the applicant apparently ignores the mandate of the numerous court decisions supporting the position given above." Final Office Action of April 22, 2003, p. 8, ¶2. The appellant respectfully submits that the appellant has not ignored "the mandate." The appellant has simply noted that the Examiner's purported motivation to combine is not a motivation. The Examiner has neither responded to this specific argument nor has she explained what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination, as required by, for example, *In re Rouffet,*

47 USPQ2d 1453 (Fed. Cir. 1998). Moreover, the appellant has not ignored the mandate but instead relied on that "mandate" to demonstrate a deficiency in the Examiner's argument. See, for example, Appellant's Response of January 13, 2003, p. 7, bottom which states in relevant part:

> Accordingly, the applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness. In addition to the claim elements not taught or suggested by the cited references as described above, the Examiner has not shown that there is some suggestion or motivation to combine the references, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. (Emphasis Added)

The Examiner goes on to state in her Final Office Action of April 22, 2003, p. 9, ¶2, that:

> In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference(s) which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner . . . .

As noted above, the appellant respectfully submits that the specific argument made by the Examiner in support of the combination of McClelland and Tyler is flawed for the specific reasons enumerated in this Appeal Brief and, for example, in the Appellant's Response of January 13, 2003, p. 7, bottom. Moreover, while the Examiner appears to be relying on "the logic and scientific reasoning of one ordinarily skilled in the art," the appellant reiterates his position that this in fact is not the case because the Examiner has failed to explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination, as required by, for example, *In re Rouffet,* 47 USPQ2d 1453 (Fed. Cir. 1998).

Finally, the Examiner states in her Final Office Action of April 22, 2003, p. 11, ¶1-2:

- 14 -

> Rather, Applicant does not point to any specific distinction(s) between the
> features disclosed in the references and the features presently claimed . . . .
>
> In response to Applicant's argument that the Examiner's conclusion of
> obviousness is based on improper hindsight reasoning . . . .

Regarding, the former statement, the appellant has specifically pointed to distinctions between the claim elements (e.g., the a "product application" and the "first support software component") and the references as described above and as described in the Appellant's Response of January 13, 2003, p. 5, ¶1 through p. 7, top. Regarding the latter statement, the appellant respectfully submits that he has presented no argument with respect to "improper hindsight reasoning."

The appellant respectfully submits that in addition to the claim elements not taught or suggested by the cited references as described above, the Examiner has failed to establish a *prima facie* case of obviousness. Accordingly, the appellant respectfully submits that claim 1 is allowable over Tyler and McClelland taken alone or in combination. Claims 2-15 depend from claim 1 and are allowable for at least this reason.

Issue IV: Whether claims 16-23 are patentable under 35 U.S.C. § 103(a) over Tyler and McClelland taken alone or in combination

Claims 16-23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tyler et al., U.S. Patent No. 5,523,942 (Tyler) in view of McClelland et al., U.S. Patent No. 5,689,650 (McClelland). The appellant respectfully traverses these rejections.

None of the cited references teach or suggest a method calculating a product rate including:

> ... converting the request for a product rate into a call to a product rate calculation software component;
>
> sending the call to a product rate calculation software component to a first support software component;
>
> receiving, at the first support software component, the call to a product rate calculation software component;
>
> processing the call to a product rate calculation software component into a protocol for transmission over a communication link; and
>
> transmitting the call to a product rate calculation software component over the communication link.

as required by independent claim 16.

Regarding claim 16, the Examiner states in her Office Action of September 12, 2002, p. 7, no. 7(G), that the claimed converting the request for a product rate into a call to a product rate calculation software component step is taught by Tyler at column 5, lines 11-18 and column 11, lines 33-36. The cited portions of Tyler state:

> The present invention also comprises a calculation engine. The calculation engine is designed to perform all required calculations related to insurance products. These calculations include determining the cash value of a policy, calculating a death benefit on an annual basis, calculating the premium due, calculating the net premium due, determining a guaranteed cash value of all individual coverages, calculating annual cash dividends, and the like.
>
> ...
>
> API Layer 14 allows the Calculation Engine 16 to be called by multiple applications (i.e., consumer applications which do not employ object

oriented technologies) to input and/or retrieve data into and from the Calculation Engine 16.

Again, the appellant respectfully submits that the particular parts of the cited reference that the Examiner has relied upon have not been designated as nearly as practicable, and the pertinence of the reference has not been clearly explained, both as required by 37 C.F.R. § 1.104(c)(2). Moreover, the appellant notes that the cited portion of Tyler does not teach or suggest *converting the request* for a product rate *into a call to a product rate calculation software component.*

As for the sending the call to a product rate calculation software component to a first support software component claim limitation, the Examiner again refers to the same portions of Tyler. Nowhere does the Examiner point out what she contends to teach the claimed first support software component. Moreover, the appellant respectfully submits that the cited portions of Tyler neither teach nor suggest such a component or sending a call to a product rate calculation software component to such a component.

Similarly, the portion of Tyler cited by the Examiner as teaching the claimed receiving, *at the first support software component,* the call to a product rate calculation software component, i.e., column 5, lines 18-32 quoted above, does not teach or suggest anything related to a first support software component.

As is the case with the appellant's "Issue III" arguments regarding claim limitations not taught by the cited references, the Examiner's response to these specific arguments and requests (all previously presented in the Appellant's Response of January 13, 2003) is to merely reiterate her original arguments. The Examiner fails to specifically respond to the appellant's arguments and requests in any meaningful way.

With respect to the arguments presented in the prosecution of the present application, the appellant respectfully submits that the Examiner has misapplied the holdings of *In re Keller* and *In re Merck & Co.* The arguments in support of this contention can be found above under "Issue III" and are hereby reaffirmed with respect to claim 16.

As for the Examiner's argument combining Tyler and McClelland, the appellant reiterates his response as outlined above under "Issue III".

As for the balance of the Examiner's statements presented in her "Response to Arguments" of the Final Office Action of April 22, 2003, the appellant reiterates his response as outlined above under "Issue III".

Accordingly, the appellant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness. In addition to the claim elements not taught or suggested by the cited references as described above, the Examiner has not shown that there is some suggestion or motivation to combine the references, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.
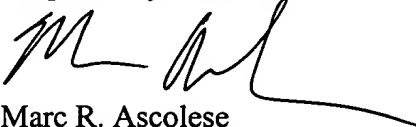
Accordingly, the appellant respectfully submits that claim 16 is allowable over Tyler and McClelland taken alone or in combination. Claims 17-23 depend from claim 16 and are allowable for at least this reason.

CONCLUSION

The appellant respectfully submits that claims 1-23 are definite and allowable over Tyler, McClelland, Batz, Adunuthula, and Narayanan taken alone or in combination. For at least the reasons stated above, claims 1-23 are allowable. The appellant respectfully requests that the Board reverse the rejections of these claims.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450, on _____ July 15 _____, 2005.

_____   ___7/15/05___
Attorney for Appellant(s)   Date of Signature

Respectfully submitted,

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- 19 -

CLAIMS APPENDIX

1   1. (Original) A product rate calculation system comprising:

2   a product application operable to provide product information to and receive

3   consumer information from a user, and further operable to send a call to a

4   product rate calculation software component;

5   a first support software component operable to receive the call from the product

6   application; and

7   a first protocol stack operable to process the call into a protocol for transmission

8   over a communication link.

1   2. (Original) The product rate calculation system of claim 1 wherein being

2   operable to send a call to a product rate calculation software component further

3   comprises being operable to send at least one pointer to a product rate calculation

4   software component interface.

1   3. (Original) The product rate calculation system of claim 2 wherein the at least

2   one pointer indicates rating information stored in a database.

1   4. (Original) The product rate calculation system of claim 1 wherein the product

2   application and the first support software component execute in a single process.

1   5. (Original) The product rate calculation system of claim 1 wherein the product

2   application further comprises at least one product application software component.

1   6. (Original) The product rate calculation system of claim 1 wherein the protocol

2   stack is a network protocol stack.

1   7. (Original) The product rate calculation system of claim 1 further comprising:

2   a product rate calculation software component having a product rate calculation

3   software component interface, the product rate calculation software

4   component for calculating a product rate depending upon rating

5   information;

6   a second support software component;

7   a second protocol stack; and

8   a communication link coupled between the first protocol stack and the second

9   protocol stack, the second protocol stack operable to receive and process a

10   transmission from the first protocol stack into the call to the product rate

11   calculation software component, the second support software component

12   for sending the call to the product rate calculation software component to

13   the product rate calculation software component interface.

1   8. (Original) The product rate calculation system of claim 7 wherein the first

2   support software component is a proxy component and the second support software

3   component is a stub component.

1   9. (Original) The product rate calculation system of claim 7 wherein the

2   communication link is a network.

1   10. (Original) The product rate calculation system of claim 7 wherein the

2   product rate calculation software component and the second support software component

3   execute in a single process.

1   11. (Original) The product rate calculation system of claim 7 wherein the rating

2   information includes at least one of consumer information and product information.

1   12. (Original) The product rate calculation system of claim 1 wherein the

2   product application is an insurance product application and the product information

3   includes an insurance product rate.

1   13. (Original) The product rate calculation system of claim 12 wherein the

2   insurance product rate is for one of home insurance, life insurance, health insurance,

3   automobile insurance, and renter's insurance.

1   14. (Original) The product rate calculation system of claim 1 wherein at least

2   one of the product application, the first support software component, and the first

3   protocol stack is encoded in a computer readable medium as instructions executable on a

4   processor, the computer readable medium being one of an electronic storage medium, a

5   magnetic storage medium, an optical storage medium, and a communications medium

6   conveying signals encoding the instructions.

1   15. (Original) The product rate calculation system of claim 1 further comprising

2   a computer system including a processor, a memory coupled to the processor, and a

3   network interface, and wherein the product application, the first support software

4   component, and the first protocol stack are encoded as instructions executable on the

5   processor.

1   16. (Original) A method calculating a product rate comprising:

2   receiving a request for a product rate from a user;

3   converting the request for a product rate into a call to a product rate calculation

4   software component;

5   sending the call to a product rate calculation software component to a first support

6   software component;

7   receiving, at the first support software component, the call to a product rate

8   calculation software component;

9   processing the call to a product rate calculation software component into a

10   protocol for transmission over a communication link; and

11   transmitting the call to a product rate calculation software component over the

12   communication link.

1   17. (Original) The method of claim 16 further comprising:

2   receiving the transmitted call to a product rate calculation software component;

3   processing the transmitted call to a product rate calculation software component

4   sending the processed call to a second support software component

5   receiving, at a second support software component, the call to a product rate

6   calculation software component;

7   sending the call to a product rate calculation software component to a product rate

8   calculation software component interface; and

9   performing a product rate calculation depending upon rating information.

1   18. (Original) The method of claim 17 further comprising retrieving rating

2   information from a database.

1   19. (Original) The method of claim 17 further comprising storing a calculated

2   product rate in a database.

1   20. (Original) The method of claim 16 wherein the receiving a request further

2   comprises receiving consumer information from a computer system.

1   21. (Original) The method of claim 16 encoded in a computer readable medium

2   as instructions executable on a processor, the computer readable medium being one of an

3   electronic storage medium, a magnetic storage medium, an optical storage medium, and a

4   communications medium conveying signals encoding the instructions.

1   22. (Original) The method of claim 16 wherein the sending the call to a product

2   rate calculation software component to a first support software component further

3   comprises sending at least one pointer the to a product rate calculation software

4   component interface.

1   23. (Original) The method of claim 16 wherein the product rate is an insurance

2   product rate.